

REMARKS

Reconsideration of the application is respectfully requested in view of the above amendments and following remarks. Claims 1-35 are pending in the present application.

Claim 15 has been amended to delete the phrase “defined above” and to move the definitions of the R¹, R², R³ and Z substituents to the end of the claim. Claim 15 is an independent claim and the definitions for the R¹, R², R³ and Z substituents can be found in the preamble of Claim 15 as originally filed, and on pages 10-11 of the specification.

Claim 28 has been amended to delete the phrase “defined above” and to move the definitions of the R¹ and R² substituents to the end of the claim. Claim 28 is an independent claim and the definitions for the R¹ and R² substituents can be found in the preamble of Claim 28 as originally filed, and on pages 15-16 of the specification.

Claim 34 has been amended to correct a typographical error in the structure of compound 1-5 by inserting a –CH₂– group between the oxygen and the phenyl group on the right side of the molecule. Support for the corrected structure of compound 1-5 in Claim 34 can be found on pages 20 and 24 of the specification.

Claim 35 has been amended to delete compound 1-2 and to correct a typographical error in the structure of compound 1-4 by inserting a –CH₂– group between the oxygen and the phenyl group on the right side of the molecule. Support for the corrected structure of compound 1-4 in Claim 35 can be found on pages 20 and 23 of the specification.

No new matter has been added to the above-captioned application by the amendments or by the addition of the new claims.

RESTRICTION REQUIREMENT UNDER 35 U.S.C. 121 AND
REQUIREMENT FOR ELECTION OF SPECIES

Applicants hereby affirm the telephonic provisional election of Group I, claims 1-35 and the species of Claim 2.

Applicants were required under 35 USC 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally allowable. Applicants elect the compound appearing in Claim 2, wherein R¹ is CN, R² is chloride and R³ is C(O)O-CH₂-phenyl, as the species.

The following claims read on the elected compound: 1, 3-15, 17-28 and 30-32. Claims 2, 16 and 29 are directed to the elected compound.

Applicants make the above election with the understanding that, if the elected species is found to be allowable, the Examiner will examine the genus claims readable thereon.

REJECTION UNDER 35 U.S.C. 112, SECOND PARAGRAPH
FOR INDEFINITENESS

Claims 15 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Claims 1-14, 16-27 and 29-32 are objected to because they contain non-elected subject matter.

The Examiner states that Claims 15 and 28 employ the term “defined above” and it is not clear whether the R groups are defined above in Claim 15 or 28, or in previous claims. The Examiner indicated that all of the “radicals” must be defined at Claims 15 and 28.

Applicants have amended Claims 15 and 28 by deleting the phrase “defined above” and by moving the definitions of the R¹, R², R³ and Z groups to the end of the claim. Both Claims 15 and 28 are independent claims in which the definitions of the R¹, R², R³ and Z groups can be found in the preamble or the body of the claim. Support for the definitions of the R¹, R², R³ and Z substituents in Claim 15 can be found in the preamble of Claim 15, and on pages 10-11 of the specification. Support for the definitions of the R¹ and R² substituents in Claim 28 can be found in the preamble of Claim 28, and on pages 15-16 of the specification.

Applicants traverse the objection to Claims 1-14, 16-27 and 29-32. Applicants respectfully submit that the objection to Claim 2 for containing non-elected subject matter is improper. Claims 2, 16 and 29 are directed to the elected species. Claims 2, 16 and 29 contain

the definitions for the R¹, R² and R³ substituents of the species elected during the telephone conversation with the Examiner on September 29, 2004. Applicants respectfully note the objection to Claims 1, 3-14, 17-27 and 30-32 and understand that the Examiner will examine these Claims in light of the elected species, and if novel, will consider the broader claims.

In view of these amendments, Applicants respectfully request that the rejection of claims 15 and 28 under 35 USC 112, second paragraph and the objection of Claims 1-14, 16-27 and 29-32 be withdrawn.

REJECTION UNDER 35 U.S.C. 102 (b) FOR
LACK OF NOVELTY

Claim 35 was rejected as being anticipated by CA 83:206332.

The Examiner states that Claim 35 is anticipated by the disclosure of compound 57381-37-0 in CA 83:206332. Compound 57381-37-0 corresponds to compound 1-2, which is claimed in Claim 35 in the present application. Applicants have amended Claim 35 to delete compound 1-2.

Applicants respectfully request that the rejection of Claim 35 under 35 USC § 102(b) be withdrawn.

REJECTION UNDER 35 U.S.C. 103(a) FOR
OBVIOUSNESS

Claim 35 was rejected as being unpatentable over CA 133:350205 and CA 2002:224612.

The Examiner states that CA 133:350205 teaches compound RN 304854-55-5, which is a bromine positional isomer of compound 1-2, which is claimed in Claim 35 of the present invention. The Examiner further states that CA 2002:224612 teaches compound 179897-89-3 in which the bromide of compound 1-2 of Claim 35 of the present invention has been replaced by a chlorine.

Applicants have amended Claim 35 to delete compound 1-2.

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In view of this amendment, Applicants respectfully request that the rejection of Claim 35 under 35 USC § 103(a) be withdrawn.

Applicants believe that all of the objections and rejections have been overcome by amendment and/or argument, and therefore earnestly solicit an early Notice of Allowance.

Respectfully submitted,

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